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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,558

09/02/2005

Jorg Hacker

H&U122

9541

7590

04/30/2008

Marlana Titus  
Nash & Titus  
6005 Riggs Road  
Laytonsville, MD 20882

EXAMINER

JOIKE, MICHELE K

ART UNIT

PAPER NUMBER

1636

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,558	<b>Applicant(s)</b> HACKER ET AL.	
	<b>Examiner</b> MICHELE K. JOIKE	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt is acknowledged of a reply to the previous Office Action, filed January 28, 2008. Claims 7 and 8 are canceled. Claims 1-6 are pending and examined.

Any objection or rejection of record in the previous Office Action, mailed July 24, 2007 that is not addressed in this action has been withdrawn. Because this Office Action introduces new rejections other than those set forth in the previous Office Action, and are not necessitated by amendment, this Office Action is Non-Final.

### ***Information Disclosure Statement***

The Examiner previously had not considered three references listed on the February 24, 2005 IDS. Applicants have provided the International Search Report which cited these references, along with a Statement Regarding Relevance of Non-English References. Based on this statement, the Examiner has considered these references and is attaching a PTO-892 form with these references listed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blum-Oehler et al in view of Trevors et al.

Applicants claim a plasmid-free clone of *E. coli* DSM 6601.

Blum-Oehler et al (IDS ref., specifically pp. 59) teach the *E. coli* strain, DSM 6601, which is also called Nissle 1917. They do not teach a plasmid-free clone of DSM 6601. However, they do teach that the plasmids (pMut1 and pMut2) are cryptic plasmids and have no apparent benefit to their host.

Trevors et al (FEMS Microbiol. Reviews 32: 149-157, 1986, specifically p. 149) teaches curing bacteria of plasmids.

The ordinary skilled artisan, desiring to have a plasmid-free clone of DSM 6601, would have been motivated to combine the teachings of Blum-Oehler et al teaching an *E. coli* strain, DSM 6601 with the teachings of Trevors et al teaching curing bacteria of plasmids because Trevors et al teach that it is desirable to cure bacteria of plasmids because it allows for a direct comparison of cells with and without plasmids. It would

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have been obvious to one of ordinary skill in the art to use E. coli strain, DSM 6601 because Blum-Oehler et al teaches that DSM 6601 is useful as a probiotic drug against intestinal disorders and diseases, and forms the basis for the drug called Mutaflor®. Given the teachings of the prior art and the level of the ordinary skilled artisan at the time of the applicant's invention, it must be considered, absent evidence to the contrary, that said skilled artisan would have had a reasonable expectation of success in practicing the claimed invention.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uraji et al in view of Blum-Oehler et al, in view of Trevors et al, and in further view of Itaya et al.

Applicants teach a method of preparing plasmid-free clones (curing) by a) introducing a resistance gene into plasmids pMut1 and pMut2, b) introducing the sacB gene into the plasmids obtained in step a), c) introducing the plasmids obtained in step b) into the E. coli strain DSM 6601 and cultivating the strain under conditions in which the naturally occurring plasmids pMut1 and pMut2 are displaced by the plasmids obtained in step b); and d) cultivating the clones obtained in step c) that substantially only permit the growth of bacteria that lack the sacB gene. pMut1 contains the tetracycline resistance cassette, and pMut2 contains the kanamycin resistance cassette. In claim 6, the bacteria are transformed with plasmid pMut1, marked with a tetracycline resistance cassette and the sacB gene, and cultivated on plates containing tetracycline and subsequently on plates containing saccharose, and that after

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elimination of plasmid pMut1 in the first step elimination of plasmid pMut2 takes place by cultivation on kanamycin plates and further cultivation on saccharose plates.

Uraji et al (Genes Genet. Syst. 77: 1-9, 2002, specifically p. 3, including figure 1 and p. 7) teaches a curing method wherein bacteria are transformed with a plasmid containing an introduced sacB gene and an introduced kanamycin resistance cassette. The bacterium already contains a second plasmid (without the sacB gene). The bacteria is then cured of both plasmids by culturing the cells overnight in LB supplemented with sucrose (also called saccharose), and then were grown on media supplemented with kanamycin. Uraji et al do not teach the sacB gene on the second plasmid, because the plasmid is already present in the cell. However, they do teach that sacB should be in a plasmid being introduced into the cell that is being cured. Therefore, if two plasmids are being introduced into the cell, it would follow that both plasmids would contain the sacB gene in order to cure the cell. In claim 6, the steps are the reverse of the method steps taught by Uraji et al. First, the transformed bacteria are cultivated on plates containing the antibiotic, and then subsequently on plates containing saccharose. As stated in MPEP 2144.04 (IV)(C), selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results.

### C. Changes in Sequence of Adding Ingredients

*Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.).

However, Uraji et al do not teach the DSM 6601 strain, or the pMut plasmids, or use of a tetracycline cassette in one of the plasmids.

Blum-Oehler et al (IDS ref., specifically pp. 59) teaches the E. coli strain, DSM 6601, which is also called Nissle 1917, which contain the pMut1 and pMut2 plasmids. However, they do not teach curing plasmids.

Trevors et al (FEMS Microbiol. Reviews 32: 149-157, 1986, specifically p. 149) teaches curing bacteria of plasmids.

Alexeyev et al (Gene 160: 63-67, 1995, see entire reference) teach a tetracycline resistance cassette in a plasmid.

The ordinary skilled artisan, desiring to have a plasmid-free clone of DSM 6601, would have been motivated to combine the teachings of Uraji et al teaching how to cure bacteria of plasmids using the *sacB* gene with the teachings of Blum-Oehler et al teaching the DSM 6601 strain with the teachings of Alexeyev et al teaching a tetracycline cassette in a plasmid because Trevors et al teach that it is desirable to cure bacteria of plasmids because it allows for a direct comparison of cells with and without

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plasmids, and one would be motivated to cure DSM 6601 because Blum-Oehler et al teach that DSM 6601 is useful as a probiotic drug against intestinal disorders and diseases, and, as taught by Blum-Oehler et al, their method is a much safer way of curing as it essentially has no effect on the host chromosome. It would have been obvious to one of ordinary skill in the art to use a tetracycline resistance cassette in one of the plasmids because Alexeyev et al teach that antibiotic-resistance gene cassettes are often used in vector construction. Furthermore, the recited elements are being used for their known and expected properties. Given the teachings of the prior art and the level of the ordinary skilled artisan at the time of the applicant's invention, it must be considered, absent evidence to the contrary, that said skilled artisan would have had a reasonable expectation of success in practicing the claimed invention.

***Allowable Subject Matter***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE K. JOIKE whose telephone number is (571)272-5915. The examiner can normally be reached on M-F, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele K Joike, Ph.D./

Michele K Joike, Ph.D.  
Examiner  
Art Unit 1636